

Arguments/Remarks

Claims 1-8 are pending and presently under rejection. Claims 1 and 5 have been amended. Withdrawal and reconsideration of the rejections are respectfully requested.

Rejections under 35 USC § 112

The Examiner has rejected claims 1-8 under 35 USC § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the claims Examiner indicates that the claims are indefinite because they do not require a patient or subject. Applicants have amended the claims. Reconsideration and withdrawal of the rejections are respectfully requested.

Rejection under 35 USC § 102

The Examiner has rejected the claims under 35 USC § 102(e) as being anticipated by commonly owned Baenteli et al (WO 03/078404). The rejection is respectfully traversed.

For a rejection to be proper under 35 USC § 102, each and every claimed element must be present in the anticipating reference. The rejection is improper in this case because Baenteli does not disclose "a method of treating a condition susceptible to treatment with an ALK inhibiting agent which comprised inhibiting ALK or a gene fusion thereof with a compound of formula I." Further, applicants have amended the claims to specific indications not disclosed in Baenteli, e.g., by eliminating non-Hodgkin's lymphoma.

The Examiner acknowledges that Baenteli does not disclose or teach the ALK inhibitory effect of the compounds, but indicates that, "this activity is a property of the compound and is necessarily present." (Office Action, page 6, first full paragraph, lines 6-8). The Examiner, in other words, is claiming the property to be inherent in the prior art.

In order to establish inherency however, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art. See MPEP 2112.IV. In the present case, the compounds of Baenteli were disclosed as being useful in treating diseases or conditions in which ZAP-70, FAK, or Syk tyrosine inhibition activity is implicated. The compounds are identical to those of the presently claimed method of

treating diseases associated with ALK inhibition. The amended claims also specifically relate to indications associated with ALK inhibition.

One of skill in the art would not recognize the compounds of Baentelli as being useful in treating or preventing a condition susceptible to treatment with an ALK inhibiting agent. The Examiner has further offered no suggestion that one of skill in the art would recognize the utility of Baentelli's compounds in the presently claimed method. Withdrawal and reconsideration are respectfully requested.

Should the Examiner have any questions, please contact the undersigned attorney.

Respectfully submitted,

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